



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,599	11/29/2001	Masayasu Ogushi	216644US0	2699

22850 7590 12/14/2004

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

AUGHENBAUGH, WALTER

ART UNIT PAPER NUMBER

1772

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/995,599

Applicant(s)

OGUSHI ET AL.

Examiner

Walter B Aughenbaugh

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004 and 15 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,8,10,11,15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,8,10,11 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 12, 2004 (Amdt. B) has been entered.

Acknowledgement of Applicant's Amendments

2. The amendments made in claims 1 and 11 in the Amendment filed October 12, 2004 (Amdt. B) have been received, considered and entered by Examiner.

3. The cancellation of claims 9, 13 and 14 in Amdt. B has been entered.

WITHDRAWN REJECTIONS

4. The 35 U.S.C. 103(a) rejection of claim 9 made of record in paragraph 13 of the Office Action mailed April 14, 2004 has been withdrawn due to Applicant's cancellation of claim 9 in Amdt. B.

5. The 35 U.S.C. 103(a) rejection of claims 13 and 14 made of record in paragraph 14 of the Office Action mailed April 14, 2004 has been withdrawn due to Applicant's cancellation of claims 13 and 14 in Amdt. B.

REPEATED REJECTIONS

6. The 35 U.S.C. 102(e) rejection of claims 1, 8 and 15 made of record in paragraph 11 of the Office Action mailed April 14, 2004 has been repeated for the reasons previously made of record in paragraph 11 of the Office Action mailed April 14, 2004.

7. The 35 U.S.C. 103(a) rejection of claims 2, 10 and 11 made of record in paragraph 12 of the Office Action mailed April 14, 2004 has been repeated for the reasons previously made of record in paragraph 12 of the Office Action mailed April 14, 2004.

RESPONSE TO DECLARATION UNDER 37 C.F.R. 1.132

8. The Declaration under 37 C.F.R. 1.132 filed October 12, 2004 has been received and considered by Examiner. The arguments presented therein have been fully considered, but are not persuasive. It is stated in the sentence bridging pages 1 and 2 of the Declaration that "the endotracheal tube of the present invention is superior in transparency to an endotracheal tube in which an ethylene/propylene copolymer as disclosed in US 6,184,291 B1 is used", but since the claims do not specify that the tube is transparent or has any particular degree of transparency, this argument is irrelevant to the invention as claimed. On page 4 of the Declaration, it is stated that "there is no motivation in USP 6,184,291 B1 to arrive at the present invention", but (1) the claims do not specify that the tube is transparent or has any particular degree of transparency and (2) there is no requirement for any sort of motivation "to arrive at" a claimed invention that is subject to a rejection under 35 U.S.C. 102.

ANSWER TO APPLICANT'S ARGUMENTS

9. Applicant's arguments regarding the 35 U.S.C. 102 rejection of claims 1, 8 and 15 made of record in paragraph 11 of the Office Action mailed April 14, 2004 presented on pages 5-6 of Amdt. B have been fully considered but are not persuasive. Applicant argues that the TAFMER polymer taught by Ahmed "is not a homopolymer", but there is no requirement that the polypropylene of claim 1 be a homopolymer: an ethylene-propylene copolymer is a polypropylene. Applicant argues that "if Ahmed's TAFMER P0480 ethylene/propylene

Art Unit: 1772

copolymer is used in place of polypropylene, an endotracheal tube with excellent transparency cannot be obtained”, but an endotracheal tube with excellent transparency is not claimed.

10. Applicant's arguments regarding the 35 U.S.C. 103 rejection of claims 2, 10 and 11 made of record in paragraph 12 of the Office Action mailed April 14, 2004⁴ presented on pages 6-7 of Amdt. B have been fully considered but are not persuasive. Applicant argues that Sterling does not teach the specific block copolymer of claim 1, but Ahmed teaches the block copolymer of claim 1, and Sterling is relied upon to teach that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have formed the resin of Ahmed into a cuff as claimed in claim 2 for the reasons provided in paragraph 12 of the Office Action mailed April 14, 2004, not to teach the block copolymer of claim 1. In the sentence bridging pages 6 and 7 of Amdt. B, Applicant argues that Sterling fails to teach a limitation of claim 1, but Ahmed teaches this limitation as made of record in paragraph 11 of the Office Action mailed April 14, 2004. Applicant argues that the “prima facie case of obviousness based on the cited prior art is rebutted by the significant improvement in transparency achieved by the present invention”, but (1) claims 1, 8 and 15 are rejected under 35 U.S.C. 102, so a case for obviousness is not required for claims 1, 8 and 15, and (2) since the claims do not specify that the tube is transparent or has any particular degree of transparency, this argument is irrelevant to the invention as claimed.

Applicant argues in the last sentence of the first full paragraph of page 7 that “Ahmed fails to suggest an elastomeric composition containing polypropylene in the recited amounts”, but the ethylene-propylene copolymer taught by Ahmed is a polypropylene, and Ahmed teaches a weight ratio value that falls within the claimed weight ratio range as made of record in paragraph 11 of the Office Action mailed April 14, 2004.

Art Unit: 1772

Conclusion


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is 571-272-1488. The examiner can normally be reached on Monday-Thursday from 9:00am to 6:00pm and on alternate Fridays from 9:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Walter B. Aughenbaugh
12/09/04

WBA


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

12/10/04